

REMARKS

Claims 1-6 and 8-79 are currently pending in the above-identified patent application. Claims 65-72 have been withdrawn from consideration. Claim 7 has been cancelled previously. Accordingly, claims 1-6, 8-64 and 73-79 remain for consideration in the above-identified patent application.

Claims 1, 3, 9, 15, 33, 35, 61, and 72 are amended in this response.

Claim 15 was objected to as dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-6, 8-10, 12-14, 16-21, 23-31, 33-41, 43-63, and 73-78 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,464,670 to Mulholland (“Mulholland ‘670”) in view of U.S. Patent No. 1,767,785 to DeSushko (“DeSushko ‘785”).

Claims 22 and 49 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of Mulholland ‘670 in view of DeSushko ‘785 as applied to claims 1 and 33 and further in view of U.S. Patent No. 4,542,020 to Jackson et al. (“Jackson et al. ‘020”).

Claims 11-12 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of Mulholland ‘670 in view of U.S. Patent No. 6,416,779 to D’Augustine et al. (“D’Augustine et al. ‘779”).

Claims 1-2, 6, 9, 12-14, 18-21, 26, 28-29, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by DeSushko ‘785.

Claims 1, 2, 8, 10-11, 13-14, 18-21, 23, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by D'Augustine et al. '779.

Claims 16-17, 24-25, 30-31, 61-64, 73-74, and 76-79 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko '785.

Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko '785 in view of Jackson et al. '020.

Claim 22 was also rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D'Augustine et al. '779 in view of Jackson et al. '020.

Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko '785 in view of U.S. Patent No. 6,270,789 to Sameshima et al. ("Sameshima et al. '789").

Claims 16-17, 24-25, 30-31, and 73-75 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D'Augustine et al. '779.

Claims 26 and 28-29 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D'Augustine et al. '779 in view of DeSushko '785.

The three-month shortened statutory period for response to this Office Action expires on September 13, 2006. Accordingly, this response is being filed in a timely manner.

Reexamination of the application as amended, reconsideration of the rejections, and allowance of the claims remaining for consideration are respectfully requested.

This response is being filed in accordance with recently revised 37 C.F.R. § 1.121, as set forth in 68 F.R. 38611 (June 30, 2003). If the amendment is considered to be not in compliance with recently revised 37 C.F.R. § 1.121, the Examiner is respectfully requested to contact the undersigned at his earliest possible convenience.

I. AMENDMENTS TO THE APPLICATION

Entry of the amendments to the application is respectfully requested. As detailed below, the amendments introduce no new matter.

Claim 1 is amended to recite that the taper occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement. Support for this added limitation is found, e.g., in Figure 5 of the present application. Similar amendments are made to other independent claims.

Claim 1 is also amended to recite that the non-meltable base member [is] immobile with respect to the meltable portion. Support for this added limitation is found, e.g., at paragraph [0084] of the specification and in Figure 15. Similar amendments are made to other independent claims.

Claim 3 is also amended to state that the non-meltable base member is wider than the meltable portion. Support for this added limitation is found, e.g., in Figure 17. Similar amendments are made to other independent claims.

Claim 15 is amended to incorporate all the limitations of claim 1, from which it depends. The substance of the claim is not altered thereby.

Accordingly, entry of these amendments is respectfully requested.

II. THE REJECTIONS UNDER 35 U.S.C. § 102

A. The Rejections of Claims 1-2, 6, 9, 12-14, 18-21, 26, 28-29, and 32  
Under 35 U.S.C. § 102(b) as Anticipated by DeSushko '785

Claims 1-2, 6, 9, 12-14, 18-21, 26, 28-29, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,767,785 to DeSushko (“DeSushko ‘785”).

To the extent that the amendments to claim 1 and 9 have not obviated this rejection, it is respectfully traversed.

This rejection is respectfully traversed, as applied to the amended claims, because DeSushko ‘785 does not disclose a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims. The taper in DeSushko ‘785 does not occupy substantially the extent of the meltable portion, but occupies only a very small portion of the length of the DeSushko ‘785 device, less than about 10%. The slope of bulge 12 in the device of DeSushko does not meet this limitation.

Additionally, DeSushko ‘785 does not disclose that the non-meltable base member [is] immobile with respect to the meltable portion.

The absence of these limitations precludes any anticipation of these claims by DeSushko ‘785. To anticipate a claim, a single source must contain all of the elements of the claim. Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 224 U.S.P.Q.409, 411 (Fed. Cir. 1984). Additionally, the single source must disclose all of the claimed elements “arranged as in the claim.” Richardson v. Suzuki Motor Co., 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Therefore, the absence of the required extent of

the taper and of the immobility of the non-meltable base member with respect to the meltable portion of the suppository precludes anticipation.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

B. The Rejections of Claims 1, 2, 8, 10-11, 13-14, 18-21, 23, and 32  
Under 35 U.S.C. § 102(b) as Anticipated by D'Augustine et al. '779

Claims 1, 2, 8, 10-11, 13-14, 18-21, 23, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,416,779 to D'Augustine et al. ("D'Augustine et al. '779").

To the extent that the amendments to claim 1 and 15 have not obviated this rejection, it is respectfully traversed.

D'Augustine et al. '779 does not disclose a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims. See, for example, Figures 12 and 13 of D'Augustine et al. '779, which shows that the length of the taper is substantially less than the extent of the meltable portion.

The absence of this limitation from D'Augustine et al. '779 precludes anticipation, as fully explained above with respect to the rejections over DeSushko '785.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

III. THE REJECTIONS UNDER 35 U.S.C. § 103

A. The Rejections of Claims 16-17, 24-25, 30-31, 61-64, 73-74, and 76-79  
Under 35 U.S.C. § 103(a) as Unpatentable Over DeSushko '785

Claims 16-17, 24-25, 30-31, 61-64, 73-74, and 76-79 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko '785.

To the extent that the amendments to claims 1, 61, and 76 have not obviated these rejections, they are respectfully traversed because a *prima facie* case of obviousness has not been established for these claims.

DeSushko '785 does not teach or suggest the limitation of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims. DeSushko '785 also fails to teach or suggest the limitation that the non-meltable base member [is] immobile with respect to the meltable portion, again as required for these claims.

In order to create a proper *prima facie* case of obviousness, the prior art references must teach or suggest all of the elements of the claimed invention. In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Determination of obviousness requires consideration of the claimed invention as a whole. Lear Siegler, Inc. v. Aeroquip Corp., 221 U.S.P.Q. 1025 (Fed. Cir. 1984). Therefore, the absence of any teaching or suggestion of the required claim limitations precludes the existence of a *prima facie* case of obviousness.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

B. The Rejection of Claim 22 Under 35 U.S.C. § 103(a) as Unpatentable Over DeSushko ‘785 in View of Jackson et al. ‘020

Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko ‘785 in view of U.S. Patent No. 4,542,020 to Jackson et al. (“Jackson et al. ‘020”).

To the extent that the amendments to claim 1 have not obviated this rejection, it is respectfully traversed.

Jackson et al. ‘020 is cited for the teaching that the suppository contains cellulose. However, the teachings of Jackson et al. ‘020 do not remedy the deficiencies in the teachings of DeSushko ‘785 as thoroughly described above.

Specifically, Jackson et al. ‘020 does not teach or suggest the limitation of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement. Jackson et al. ‘020 also fails to teach or suggest the limitation that the non-meltable base member [is] immobile with respect to the meltable portion, as required by these claims.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

C. The Rejection of Claim 22 Under 35 U.S.C. § 103(a) as Unpatentable over D’Augustine et al. ‘779 in View of Jackson et al. ‘020

Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D’Augustine et al. ‘779 in view of Jackson et al. ‘020.

To the extent that the amendments to claim 1 have not obviated this rejection, it is respectfully traversed.

This rejection is respectfully traversed for the same reasons as the rejection under 35 U.S.C. § 103(a) over DeSushko ‘785 in view of Jackson et al. ‘020, described above. The deficiencies in the teachings of D’Augustine et al. ‘779 are not remedied by Jackson et al. ‘020.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

D. The Rejection of Claim 23 Under 35 U.S.C. § 103(a) as Unpatentable Over DeSushko ‘785 in View of Sameshima et al. ‘789

Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over DeSushko ‘785 in view of U.S. Patent No. 6,270,789 to Sameshima et al. (“Sameshima et al. ‘789”).

To the extent that the amendments to claim 1 have not obviated this rejection, it is respectfully traversed.

Sameshima et al. ‘789 was cited for the use of antibiotics in a medicament included in a urethral suppository. However, Sameshima et al. ‘789 does not remedy the deficiencies in the teachings of DeSushko ‘785 described above.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

E. The Rejections of Claims 16-17, 24-25, 30-31, and 73-75 Under 35 U.S.C. § 103(a) as Unpatentable Over D’Augustine et al. ‘779

Claims 16-17, 24-25, 30-31, and 73-75 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D'Augustine et al. '779.

To the extent that the amendments to claims 1 and 33 have not obviated these rejections, they are respectfully traversed.

These rejections are respectfully traversed because no *prima facie* case of obviousness exists with respect to D'Augustine et al. '779.

As described above, D'Augustine et al. '779 does not teach or suggest the limitation of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims. D'Augustine et al. '779 also fails to teach or suggest the limitation that the non-meltable base member [is] immobile with respect to the meltable portion, again as required for these claims.

The absence of any teaching or suggestion of these claim limitations from the disclosure of D'Augustine et al. '779 precludes the existence of a *prima facie* case of obviousness of these claims.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

F. The Rejections of Claims 26 and 28-29 Under 35 U.S.C. § 103(a) as Unpatentable Over D'Augustine et al. '779 in View of DeSushko '785

Claims 26 and 28-29 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over D'Augustine et al. '779 in view of DeSushko '785.

To the extent that the amendments to claim 1 have not obviated these rejections, they are respectfully traversed. No *prima facie* case of obviousness exists with respect to these claims.

Neither D'Augustine et al. '779 nor DeSushko '785 discloses or teaches the limitations does not teach or suggest the limitation of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims. Similarly, neither D'Augustine et al. '779 nor DeSushko '785 also fails to teach or suggest the limitation that the non-meltable base member [is] immobile with respect to the meltable portion, again as required for these claims.

The absence of these limitations from the teachings of the prior art means that, even if combined, D'Augustine et al. '779 and DeSushko '785 do not result in the claimed invention.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

#### IV. THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

##### A. The Rejections of Claims 1-6, 8-10, 12-14, 16-21, 23-31, 33-41, 43-63, and 73-78 for Obviousness-Type Double Patenting Over Claims 1-21 of Mulholland '670 in View of DeSushko '785

Claims 1-6, 8-10, 12-14, 16-21, 23-31, 33-41, 43-63, and 73-78 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,464,670 to Mulholland ("Mullholand '670") in view of DeSushko '785.

To the extent that the amendments to the claims have not obviated these rejections, these rejections are respectfully traversed because neither the invention defined by claims 1-21 of Mulholland '670 nor the disclosure of DeSushko '785 includes the limitations of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims or that the non-meltable base member [is] immobile with respect to the meltable portion, again as required for these claims.

An obviousness-type double patenting rejection is considered analogous to a rejection for obviousness under 35 U.S.C. § 103. In re Longi, 225 U.S.P.Q. 645 (Fed. Cir. 1985). There needs to be some clear evidence why the invention's variation in the second application would have been obvious. In re Kaplan, 229 U.S.P.Q. 678 (Fed. Cir. 1986).

The absence of any teachings of these limitations in either the claims of Mulholland '670 or the disclosure of DeSushko '785 precludes any existence of obviousness-type double patenting for these claims.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

B. The Rejections of Claims 22 and 49 for Obviousness-Type Double Patenting Over Claims 1-21 of Mulholland '670 in View of DeSushko '785 and Further in View of Jackson et al. '020

Claims 22 and 49 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of Mulholland '670 in view of DeSushko '785 and further in view of Jackson et al. '020.

As applied to the amended claims, these rejections are respectfully traversed for the reasons described above. Jackson et al. '020 is cited for the teaching that the suppository contains cellulose. However, the teachings of Jackson et al. '020 do not remedy the deficiencies in the claims of Mulholland '670 and the teachings of DeSushko '785 as described above.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

C. The Rejections of Claims 11-12 for Obviousness-Type Double Patenting Over Claims 1-21 of Mulholland '670 in View of D'Augustine et al. '779

Claims 11 and 12 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of Mulholland '670 in view of D'Augustine et al. '779.

As applied to the amended claims, these rejections are respectfully traversed.

There is no obviousness-type double patenting for the same reasons as described above with respect to the obviousness-type double patenting rejection over claims 1-21 of Mulholland '670 in view of DeSushko '785. As for DeSushko '785, D'Augustine '779 fails to teach or suggest the limitations of a taper that occupies substantially the extent of the meltable portion from the second end of the reinforcement to the first end of the reinforcement, as required by these claims or that the non-meltable base member [is] immobile with respect to the meltable portion, again as required for these claims.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

V. ALLOWABLE SUBJECT MATTER

Claim 15 was objected to as dependent on a rejected base claim. However, claim 15 was considered to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claim 15 has now been rewritten as requested.

Accordingly, claim 15 is allowable.

VI. CONCLUSION

In conclusion, all claims remaining for consideration are neither anticipated by nor obvious over the prior art of record, whether considered individually or in combination. These claims are not subject to obviousness-type double patenting.

Accordingly, prompt allowance of these claims is respectfully requested.

Respectfully submitted,



Michael B. Farber, Ph.D., Esq.  
Reg. No.: 32,612

Date: September 8, 2006

CATALYST LAW GROUP, APC  
9710 Scranton Road, Suite 170  
San Diego, California 92121  
(858) 450-0099  
(858) 450-9834 (Fax)